REMARKS

In view of the following remarks, the Examiner is requested to allow claims 1-23 and 25-29, the only claims pending and under examination in this application.

Claim 24 has been cancelled. New Claim 30 has been added. New Claim 30 finds support at page 8, line 17 and in the experimental section. As such, this claim introduces no new matter and its entry by the Examiner is respectfully requested.

Claim Rejections – 35 U.S.C. § 103(a)

Claims 1-23 and 25-29 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Wenz (WO 2004/050131 in view of Constantz et al. (USPN 6,334,891) and Constantz et al. (USPN 6,719,993).

According to the MPEP § 706.02 (j), to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The rejected claims are directed to methods of producing a flowable composition (e.g., a paste) that sets into a calcium phosphate containing product and a kit or package containing the same. An element of the claims is a water-soluble contrast agent that is incorporated into the calcium phosphate product. The Applicants contend that Wenz is deficient in that it does not teach or suggest a water-soluble contrast agent that is incorporated into the calcium phosphate product.

In making the rejection, the Office, asserts that because Wenz discloses the use of barium iodide, as an additive for use in the formation of a cement composition, Wenz teaches "a water soluble contrast agent," as claimed by the Applicants. See page 4 of the Office Action mailed June 30, 2006.

However, the Applicants contend that to the extent that Wenz discloses the use of an iodide compound as a water soluble contrast agent, the iodide compound is not incorporated into the calcium phosphate product. Rather, Wenz discloses that the "iodo" compound additive (e.g., the soluble contrast agent) is leaked out of and eliminated from the cement product. See page 8, lines 12 to 16.

In support of its position, the Office asserts that Wenz merely discloses that the radiopacity enhancing additive is *capable* of being eliminated from the cement product but does not positively recite that the additive *is* eliminated from the cement product. See page 10 of the Office Action mailed June 30, 2006.

However, the referenced passage of Wenz (page 8, lines 11 to 16) actually states the following:

> [0025] Furthermore, depending on the purpose and the intended use, the additive for enhancing radiopacity may be capable of being stably incorporated into the reaction product of the cement preparation, for example iron compounds or compounds of other radiopacity enhancing metal elements like oxides, sulfates or phosphates. Alternatively, the additive for enhancing radiopacity is capable of being loosely incorporated but eliminated from, or leaked out of the hardened cement product after being applied to the desired target, in order to improve bio-compatibility and to minimize tissue irritation at the target site; for example, a water soluble additive for enhancing radiopacity may be selected, such as a water soluble iodo compound.

As can be seen with reference to the above passage, what Wenz actually teaches is that if stable incorporation of the radiopacity enhancing agent is desired, then compounds such as metal oxides, phosphates or sulfates should be used as the

enhancing agent. However, if a loose association is desired, a water soluble enhancing agent, e.g. a water soluble iodo compound, should be used. Hence, Wenz teaches the use of a water soluble iodo compound as an example of a radiopacity enhancing additive that is not incorporated into the cement product but *is* leaked out of and eliminated from the cement product.

Accordingly, contrary to the assertion of the Office, Wenz does not teach or suggest a water-soluble contrast agent that is incorporated into the calcium phosphate product because, as can be seen with reference to the above, the iodide compounds disclosed by Wenz are not incorporated into the calcium phosphate product but rather *are* leaked out of and eliminated from the final cement product. As Constantz '891 was cited solely for its disclosure of various components that may be included in a kit and Constantz '993 was cited for its disclosure of the use of a silicate solution, they fail to remedy the deficiencies of Wenz.

Therefore, the Applicants contend that a *prima facie* case of obviousness has not been established because the recited combination does not teach every element of the claimed invention, namely, a water-soluble contrast agent that is incorporated into the calcium phosphate product. In view of the above, the Applicants respectfully request that the 35 U.S.C. § 103(a) rejection of Claims 1-23 and 25-29 be withdrawn.

New Claims

New Claim 30 depends from Claim 1. Accordingly, for the reasons stated herein above, New Claim 30 is patentable over the cited art.

CONCLUSION

Applicants submit that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone the undersigned at the number provided.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-0815, order number SKEL-007.

Respectfully submitted,
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